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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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LOWE HAUPTMAN GILMAN & BERNER, LLP
Suite 310
1700 Diagonal Road
Alexandria, VA 22314

EXAMINER

LIPMAN, JACOB

ART UNIT PAPER NUMBER

2134

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/897,416

Applicant(s)

SCHWENCK ET AL.

Examiner

Jacob Lipman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/22/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 23-47, 49 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

AT

DETAILED ACTION

Specification

1. The amendment filed 22 August 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In claim 15, the component being completely enclosed is new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

2. Claim 22 is objected to because of the following informalities: Claim 22 indicates that it is original when it has been amended. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The component being completely enclosed is new matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 8-17, 20, and 22, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Candelore, US patent number 5,861,662.

With regard to claim 1, Candelore discloses a tamper resistant electronic module (column 2 lines 49-50) comprising an electronic component (column 2 lines 50-51), a tamper resistant sheet (wire, column 2 lines 61-64, column 4 lines 53-56), and encapsulant material (epoxy, column 2 lines 54-56). Wherein the sheet comprises a tell-tale conductive trip (column 2 lines 57-64), which covers the component (column 8 lines 1-11) and an electronic radiation shield layer (column 5 lines 13-22).

With regard to claims 2 and 3, Candelore discloses the layers are coated with plastic (column 5 lines 39-42).

With regard to claim 4, Candelore discloses the tamper resistant sheet is encapsulated in the material (column 2 lines 49-56).

With regard to claim 8-10 and 22, Candelore discloses using a PCI card (column 3 lines 45-47), which is not precisely flat.

With regard to claims 11, 14, and 15, Candelore discloses encapsulating a portion of the smart card extends the wire above and below the component (column 7 lines 51-57).

With regard to claims 12 and 13, Candelore discloses multiple layers (column 5 lines 12-30), which are also separate sheets.

With regard to claims 16 and 17, Candelore discloses having a power supply and sensor (column 5 lines 13-17).

With regard to claim 20, Candelore discloses having a breakable material, which will break or crack if drilling is attempted (column 5 lines 39-48).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6, 18, 19, 21, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore.

With regard to claim 6, Candelore discloses group ii and group i, as outlined above, but does not specifically mention sandwiching group ii within two layers of group i. Candelore does disclose locating the shield (group I) within the encapsulation layer, and having multiple layers (column 5 lines 22-25). Having the layer of group ii between the disclosed multiple layers of group i is seen as an obvious configuration. It would have been obvious for one of ordinary skill in the art to use this configuration to separate the layers on group I, and protect each layer with a group I layer.

With regard to claims 18, 19, and 48, Candelore discloses the module of claim 17, as outlined above, but does not disclose time-stamping the tamper attempt. The

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examiner takes official notice that tampering attempts are typically time stamped. It would have been obvious for one of ordinary skill in the art to timestamp a tamper attempt in Candelore to help investigate system vulnerability (see response to arguments for reference).

With regard to claim 21, Candelore discloses the module of claim 20, as outlined above, but does not disclose specifically making the sheet resistant to laser. The examiner takes official notice that lasers are well-known cutting devices. It would have been obvious for one of ordinary skill in the art to protect against lasers in addition to the breaking methods already protected by Candelore.

Allowable Subject Matter

1. Claims 5 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

With regard to claim 5, Candelore discloses the module of claim 4, as outlined above, but does not specifically mention the encapsulating material being opaque. Candelore does not provide motivation to make the tamper resistant sheet hidden, and thus it would not have obvious to one of ordinary skill in the art to make this modification.

With regard to claim 7, claim 6 would be obvious over Candelore, as outlined above, but the further details of claim 7 are not seen as obvious to one of ordinary skill in the art, since it is not an obvious configuration.

Response to Arguments

2. Applicant's arguments filed 22 August 2005 have been fully considered but they are not persuasive.

With regard to applicant's argument that the sheet and encapsulant are the same in Candelore, the examiner points to column 4 lines 53-56 or column 8 lines 1-11 (as in the prior office action). Candelore discloses the wire as a mesh grid covering the components. This is the sheet as claimed by applicant. The sheet also includes shield 230 (column 5 lines 13-22), as indicated in the prior office action.

With regard to applicant's argument that there is no indication of epoxy layer 210 being a flexible layer, the examiner again points to column 5 lines 39-41, where Candelore discloses the epoxy being in a molten state and flows around and below the wire. Molten epoxy that flows certainly is not self-supporting when held vertically. The examiner further points out that the term "said layers are of a flexible" is broad terminology, which is read as being made of flexible material, but is not necessarily still flexible. It is also submitted that inherently, wires, glass, epoxy, and metal, are all made from molten material, which is flexible.

With regard to applicant's argument that an smart card is not a PCI card, the examiner points out that Candelore discloses smart cards interact with computers, and are thus PCI cards (column 7 lines 35-48).

With regard to applicant's arguments in reference to claims 14 and 20, the examiner points out that the reason applicant is "unable to understand" the office action is that applicant is reading the protective sheet as the epoxy, while it is in-fact the wire mesh, as explained above.

With regard to applicant's argument that insufficient rationale is stated for the configuration of claim 6, the examiner disagrees, as the prior office action states, "to protect each layer with a group 1 layer". The examiner further points out that duplicating a part for a multiple effect is a modification that within the level of one of ordinary skill in the art, *In Re Harza*, 274 F.2d 669, 671, 124 USPQ 378, 380 (CCPA 1960).

With regard to applicant's request that the examiner give support for the official notice that tamper attempts are often time-stamped, the examiner points to Kadner et al., USPN 6,069,563 (column 4 lines 23-30).

With regard to applicant's argument that the examiner does not show the laser proof sheet to either diffuse or reflect the laser, the examiner points out that these would have been two obvious methods of preventing a laser from cutting. It is unclear to the examiner what other options might exist.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Lipman whose telephone number is 571-272-3837. The examiner can normally be reached on M-Th 7 AM-3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 571-272-3838. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JL


GREGORY MORSE
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER 2100